

REMARKS

This Amendment is submitted in response to the Office Action mailed June 25, 2002. Claims 1, 11 and 13 are amended herein. Claims 2, 14 and 16-20 are cancelled while new claims 21-32 are added. No new matter is added by these amendments. Claims 1, 3-13, and 15-22 are pending.

Election/Restriction

Applicants hereby affirm the election of the invention of Group I, claims 1-15, without traverse.

Claim Amendments

Claims 1 and 14 are amended to clarify the relationship between the first adhesive field and the second adhesive field of the adhesive construction of the present invention. Applicants respectfully submit that these amendments do not narrow the amended claims but merely clarify their intended meaning. Claim 11 is amended to correct a typographical error. New claims 23 and 24 relate to a screen printing process being used to apply two different adhesive fields and are supported at page 8, lines 17-24 in the application as originally filed.

Interview Summary

On October 23, 2002, the Applicant's undersigned representative, Kate DeVries Smith, conducted a telephone interview with Examiner Victor Chang and Examiner Daniel Zirker. The Applicant's representative pointed out elements of the claims not found in U.S. Patent No. 5,351,426 to Voy et al. ("Voy") or in U.S. Patent No. 5,409,754 to Yasuda et al ("Yasuda"). The lack of motivation to combine Voy and Yasuda was also discussed. No agreement was reached regarding the claims.

Claim Rejections

Claims 1-15 were rejection under 35 U.S.C. § 103 as being unpatentable over Voy in view of Yasuda. Applicant respectfully traverses the rejection. The content of Voy teaches away from a combination with Yasuda, so that the combination of the two references is not proper. Further, neither Voy nor Yasuda teach the specific numerical adhesive concentrations found in independent claims 1 and 13. For these reasons, Applicant respectfully submits that the pending claims are in condition for allowance.

First, there is no motivation to combine Voy and Yasuda. In explaining the alleged motivation to combine the references, the Examiner argues that one of the benefits of the reduced adhesion zone in Voy is to improve the releasability of the labels from the carrier sheet during label application. The Examiner further argues that Yasuda teaches that a less adhesive zone 4 can be formed by depositing fifty percent adhesive density in a central area, as shown in Figure 1. The Examiner goes on to argue that it would have been obvious to one of ordinary skill in the art to modify the construction taught in Voy of having an adhesive free zone at the perimeter of the label to instead have a reduced adhesive zone at the perimeter of the label, motivated by the desire to achieve improved releasability of the labels from the carrier sheet.

Applicant respectfully submits that modifying the construction taught in Voy to have a reduced adhesive zone instead of an adhesive free zone at its periphery would not further the goal of releasability of the label. In contrast, it would decrease the releasability of the label compared to the construction that is taught in Voy.

In addition, Voy teaches away from a modification to have a reduced adhesive zone at its periphery. Voy states at column 4, lines 43-49 that an object of the invention is to allow the die cutting of each element without fouling the apparatus with adhesive or jamming the apparatus. By providing an adhesive free zone, the apparatus is not fouled with adhesive. However, the provision of a reduced adhesive zone at the periphery would not achieve this goal. In addition, at column 3, line 63 through column 4, line 10, Voy discusses the advantage of preventing adhesive migration beyond predetermined

boundaries prior to curing of the adhesives. This goal would also not be achieved if the adhesive free zone were replaced with a reduced adhesive zone.

Modifying a characteristic of an invention where the modification would defeat the purpose of the original characteristic is not appropriate in constructing an obviousness rejection. In re Haruna, 259 F.3d 1327, 1336 (Fed. Cir. 2001). In Haruna, the claim at issue was to an ornamental design for a prerecorded optical disk. Id at 1329. The design differed from conventional prerecorded optical disks in that the metalized region of the disk stopped well short of the outer rim and the disk had a relatively wide transparent region adjacent to the outer rim. Id at 1329. The Examiner rejected the claim based on a patent describing a way of manufacturing disks to conceal any cosmetic defects in an outer zone by treating a surface of the outer zone so that the disk reflects light falling in the outer zone at least partially diffusely and/or absorbs at least partially. Id at 1331. The cited patent taught that where the outer zone is not metalized the outer zone might be treated to provide a matt finish or a colored surface or pattern. Id at 1336. The Examiner and the Board of Patent Appeals And Interferences determined that the cited patent, combined with the general knowledge that conventional disks have a narrow transparent region at their rims, rendered the claimed design obvious. Id at 1336. However, the Federal Circuit found that this determination ignored the teachings of the cited patent. Id at 1336. The cited reference taught away from the claimed invention because providing a transparent region would not conceal any defects and would result in a large region where defects would be readily apparent. Id at 1336.

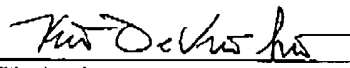
Similarly, in the obviousness rejection at issue, changing the adhesive free zone of Voy to make it a reduced adhesive zone would hinder the purpose of having the adhesive free zone in the first place. Therefore, Voy teaches away from combining Voy with Yasuda.

For the reasons discussed above, claims 1 and 13 are patentable over Voy in view of Yasuda. Dependent claims 3-12 and 14-22 are also patentable for at least the same reasons. In addition, Applicant respectfully submits that new claims 23-32 are patentable and in condition for allowance. In view of the above, favorable reconsideration of the claims is respectfully requested.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADEIn the Claims

Claims 1, 11 and 13 have been amended.

1. (Once Amended) An adhesive construction comprising:
 - (a) a flexible substrate [defining a] having a first side and defining an outer perimeter edge;
 - (b) a first adhesive field comprising pressure sensitive adhesive and an outer perimeter adhesive field positioned on the first side of the flexible substrate and adjacent the outer perimeter edge;
 - (i) the first adhesive field being a discontinuous pattern of adhesive with adhesive covering no more than 80% of an area of a portion of the first side of the flexible substrate defined by the first adhesive field; the area of a portion of the first side of the flexible substrate defined by the first adhesive field being at least 10 sq. mm. and,
 - (c) a second adhesive field comprising pressure sensitive adhesive and an inner adhesive field spaced from the outer perimeter edge and completely surrounded by the first adhesive field;
 - (ii) the second adhesive field covering at least 90% of an area of a portion of the first side of the flexible substrate defined by the second adhesive field; the area of a portion of the first side of the flexible substrate defined by the second adhesive field being at least 10 sq. mm.
11. An adhesive construction according to claim [11] 10 wherein:
 - (a) the outer perimeter edge has no segment of extension of greater than 5 mm., at which there is not adhesive on the substrate first side and immediately adjacent the outer perimeter edge.

13. (Once Amended) A roll of adhesive constructions; the roll comprising:
- (a) an extension of release liner;
 - (b) at least 10 spaced adhesive constructions secured to the extension of release liner; each adhesive construction comprising:
 - (i) a flexible substrate having a first side and defining an outer perimeter edge;
 - (ii) a first adhesive field comprising pressure sensitive adhesive and an outer perimeter adhesive field positioned on the first side of the flexible substrate and adjacent the outer perimeter edge;
 - (A) the first adhesive field being a discontinuous pattern of adhesive with adhesive covering no more than 80% of an area of a portion of the first [site] side of the flexible substrate defined by the first adhesive field; the area of a portion of the first side of the flexible substrate defined by the first adhesive field being at least 10 sq. mm.; and,
 - (iii) a second adhesive field comprising pressure sensitive adhesive and an inner adhesive field spaced from the outer perimeter edge and completely surrounded by the first adhesive field;
 - (A) the second adhesive field covering at least 90% of an area of a portion of the first side of the flexible substrate defined by the second adhesive field; the area of a portion of the first side of the flexible substrate defined by the second adhesive field being at least 10 sq. mm.

New claims 21-32 have been added.